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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/812,895

03/31/2004

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01/19/2007

EXAMINER

NOBLE, MARCIA STEPHENS

ART UNIT

PAPER NUMBER

1632

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/812,895

Applicant(s)

TAKESHITA ET AL.

Examiner

Marcia S. Noble

Art Unit

1632

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 28 November 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☒ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☒ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 10-15.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

Anne-Marie Falk

ANNE-MARIE FALK, PH.D
PRIMARY EXAMINER

Continuation of 3. NOTE: The amendments to the claims neither overcome the rejections of record nor do they place the application in better form for allowance or appeal and also introduces a new matter rejection.

In the Final Rejection, mailed 8/28/2006, a new matter rejection was made for the recitation of "an identical depth" (claims 10 and 13), which is not supported by the specification. Applicant submitted amendments to the claims, which were filed 11/28/2006, for after-final consideration. Applicant deleted the recitation of "an identical depth" and the amended claims now also recite, 'positioned within an amphibian oocyte at a depth from a surface of amphibian oocyte identical to a depth of mRNA positioned in all others...'. This new recitation also raises new matter issue for similar reasons previously stated in the Final rejection. In Applicant's remarks, filed 11/28/2006 (p.4 last par), Applicant recites support for this amendment from the specification stating "since mass production of oocytes having an identical condition for injection". The Amendment to the claims and the arguments provided by Applicant do not obviate the instant new matter rejection of record because although the wording is different in the claims, they still recite "at a DEPTH from a surface of said amphibian oocyte IDENTICAL TO A DEPTH..." which essentially encompasses the same limitations of the previous claim set, filed 8/28/2006, and therefore is also not supported by the specification for the same reasons that "an identical depth" is not supported by the specification. The specification teaches that there is variability due to size and shape of the oocyte that can result in a more superficial injection. Therefore, the injection would not occur at a "depth from the surface of said amphibian oocyte identical to a depth" as claimed. Applicant's arguments that "identical conditions" recited in the specification is support for the amendments are not found persuasive because "identical conditions" encompass a broader range of factor and do not specifically address the depth of injections as is encompassed by the claims. Furthermore, as discussed above, the specification discloses variability in the injection depth and therefore does not support "a depth from a surface of said amphibian oocyte identical to a depth" as claim.

In the Final Rejection, mailed 8/28/2006, claim 13 and dependent claims 14 and 15 are deemed indefinite under 112 2nd paragraph because the relationship between the claimed solution and sample is not clear. The amendments to claim 13 in the After-Final, filed 11/28/2006, do not clarify the relationship between the claimed solution and sample. Applicant's only arguments in reference to the 112 2nd paragraph rejections of record are a broad statement stating, "the claims are being amended to correct formal error and/or better recite or describe the features of the present invention as claim in accordance with the Examiner's requirement" (p. 5, lines 5-9 of remarks filed 11/18/2006). These arguments and the amendments to the claims do not recify the issue of indefiniteness in these claims. Therefore the amendments do not overcome this rejection nor do they place the application in better form for allowance or appeal..

In the Final rejection, mailed 8/28/2006, claims 10-15 stand rejected as being anticipated by Brown et al (Pat No. 5,688,938). In the After-final Amendment, filed 11/28/2006, Applicant continues to traverse this rejection on the grounds that "Brown merely injects mRNA into the vegetal pole of the oocytes, wherein a 35 mm culture dish with a patch of nylon stocking fixed to the bottom is used to secure the oocytes. This reference does not disclose, teach, or suggest any structure or process for obtaining a plurality of amphibian oocytes into which mRNA is injected into each oocyte at identical depths as recited in the claims" (p. 6 lines 7-11 of remarks filed 11/28/2006). These arguments are not found persuasive for the reasons previously made of record in the Final Rejection. Again as stated in the Final rejection, "First, as previously described in the Non-Final Action (sentence bridging p 4 to 5 and sentence following on p 5), the specification of Brown et al does define the injection depth as 0.02-0.1mm from the cell surface via an injection into the vegetal pole. This provides no more or less of an "identical injection depth" than that of the instant claims (see claim 12 and 15). Second, claims 10-12 are drawn to a product that required mRNA injected into is cytoplasm. As long as the product has the same components it can be produced by any means. Brown discloses oocytes with an mRNA in its cytoplasm that has injected into its cytoplasm, therefore meeting the limitations of the claims." (p. 9, first par of Final Rejection mailed 8/28/2006). Again, Brown teaches process and product of amphibian oocytes with injected RNA at an injection depth range to that disclosed in the instant application, therefore inherently the parameters of an "identical depth" will be the same between the instantly claimed product and process and that of Brown. The claims do not specify any aspects of a device for injection of the oocytes therefore that argument that Brown used a 35 mm culture dish with a patch of nylon stocking fixed to the bottom is used to secure the oocytes has no bearing on the whether the claim limitations have been met. Therefore because the amendments to the claims do not obviate the rejection of record and Applicant's arguments have not been found persuasive, the amendments to the claims do not place the application in better form for allowance or appeal.

So overall, because the amendments introduce new matter issues, and do not overcome the 112 2nd, and 102 rejections of record and does not place the application in better form for an allowance or appeal, the amendment to the claims are not being entered.

Continuation of 5. Applicant's reply has overcome the following rejection(s): Claims 10-12, rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 6, 803, 207, has been withdrawn because Applicant filed a Terminal Disclaimer on 11/28/2006 that was approved on 12/11/2006.

Continuation of 11. does NOT place the application in condition for allowance because: the amendment to the claims have not been entered and therefore the rejections of record are maintained.